

Applicant: John E. Stockenberg, *et al.*
U.S.S.N.: 09/052,325
Filing Date: March 31, 1998
EMC Docket No.: EMC-97-137

REMARKS/ARGUMENTS

In response to the Advisory Action mailed May 5, 2005, the applicants respectfully request reconsideration and entrance of the foregoing amendment. In the Advisory Action, the rejection of claims 1-20 was maintained. By this amendment, claim 1 has been amended. Accordingly, upon entrance of this amendment, claims 1-20 will remain pending in this application.

Rejection Under 35 U.S.C. §112

In the Advisory Action, the examiner withdrew the rejection of claim 17 under 35 U.S.C. §112, second paragraph.

Drawing Objections

Applicants submitted a new set of drawings including Figures 1-7 in response to the examiner's objection to the drawings in applicants previous response mailed April 13, 2005.. The examiner required new corrected drawings, stating that, because of a scanning problem with the electronic file, figures 1, 2, 4, 4A and 5-7 do not have legible labels on the drawing figures or numbers for parts of the drawing.

Since the objection to the drawings was not addressed in the Advisory Action, the applicants will assume that the new set of drawings has overcome the examiner's objection.

Rejection Under 35 U.S.C. §103

Claims 1-20 remain rejected under 35 U.S.C. §103(a) as being unpatentable over various combinations of Yanai, Ofek and Ji. Although the Advisory Action only lists claims 1-17 as being rejected, the applicants' arguments against the rejection are addressed to all of the pending claims. Based on the arguments set forth in previous responses and the following arguments, this rejection is traversed.

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Applicants will address each of the issues raised by the examiner in the Advisory Action in support of the examiner's position, plus issues raised in response to the applicants' previous response.

Issue No. 1: Applicants have argued that there is no motivation to combine the references as suggested by the examiner. In addressing this argument, the examiner has simply repeated the claim language and stated that Yanai or Ofek teach certain portions of the claimed invention. There is absolutely no support in the examiner's argument for the position that there is a motivation to combine the references.

In the Advisory Action, the only support for the examiner's combination of Yanai and Ofek was the statement that the references were combinable because "Yanai is listed in the listing of references on the front page of the Ofek reference."

The applicants have never heard of this rationale or are aware of any case law that states this support for the motivation to combine references under 35 U.S.C. §103. According to Section 2142 of the M.P.E.P.:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.... To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.... The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. (Emphasis added).

As set forth above, for references to be properly combinable, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references. The examiner bears the

initial burden of factually supporting any prima facie conclusion of obviousness. The examiner has provided no such factual support .

Furthermore, the examiner has the burden of supporting the obviousness conclusion by either (a) showing that the references suggest the claimed invention or (b) presenting a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. To date, and for the first time in the Advisory Action, the examiner has only supported the combination by pointing out that one reference was cited on the face of the other.

Applicants hereby traverse the examiner's factual assertion of what constitutes a proper combination under §103 as not properly based upon common knowledge. As stated in M.P.E.P. §2144.03C, "If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained."

Since the examiner has only been able to support the propriety of the combination of Ofek and Yanai by pointing out that Yanai is listed as a reference on Ofek, and since the rejection of claims 1-20 relies solely on the combination of Ofek and Yanai, applicants assert that, if the examiner cannot provide documentary evidence to support the examiner's position, the rejection of claims 1-20 under 35 U.S.C. §103(a) is improper and must be withdrawn, and that claims 1-20 be allowed.

Issue No. 2: Applicants have argued that Yanai does not teach a system having first and second processes residing on first and second computers, the first and second processes being used with at least one of backup and restore operations, wherein each of said first and said second computers are in communication with both a data storage system which stores data from at least said first and second computers and a network. Applicants also argued that the examiner has not pointed out the first and second computers taught by Yanai that have first and second processes or that are in communication with both a data storage system which stores data from at least said first and second computers and a network.

In response to this argument, the examiner never provides support for the examiner's assertion that Ofek and Yanai teach the claimed invention, but instead, the examiner states that

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applicants are arguing the preamble and not what is in the claim language. The examiner suggests that the wording be incorporated into the body of the independent claim.

Accordingly, independent claim 1 has been amended to incorporate the language into the body of the claim. Therefore, applicants assert that independent claim 1 is allowable over the cited references.

Claim 17, which the examiner rejected based on the same rationale as claim 1, does not have the language referred to by applicants in the preamble. Such language is recited in the body of the claim.

Accordingly, applicants assert that independent claim 17 is allowable over the cited references.

Issue No. 3: Applicants have argued that Yanai does not teach at least one first communication mechanism residing on each of the first and second computers for facilitating communications between the first and second processes that are each used with backup or restore operations over the network and a second communication mechanism residing on each of the first and second computers for facilitating communication between the first and second processes through the data storage system.

In response to this argument, the examiner does not specifically indicate where Yanai teaches the elements recited in the claims, but instead states, "Where are these limitations in the claims? The examiner does not find the second part of the claim limitation in the claim language. Applicants are respectfully requested to point out in the claim language the second limitation or to incorporate the limitation into the claims in the same wording."

Below is independent claim 1, as amended by this amendment:

A system ~~having~~ comprising:

first and second processes residing on first and second computers, respectively, the first and second processes being used with at least one of backup and restore operations, wherein each of said first and said second computers are in communication with both a data storage system which stores data from at least said first and second computers and a network; ~~said system comprising:~~

at least one first communication mechanism residing on each of said first and second

computers for facilitating communications between said first and second processes, that are each used with backup or restore operations, over said network;

a second communication mechanism residing on each of said first and second computers for facilitating communication between said first and second processes through said data storage system; and

means, within said first and second processes, for allowing said first and second processes to determine whether a communication to be facilitated between said first and second processes is from the first communication mechanism or the second communication mechanism and, in response to determining that a communication is from said first communication mechanism, facilitating the communication between the first process and the second process over said network, and, in response to determining that a communication is from said second communication mechanism, facilitating the communication between the first process and the second process through said data storage system.

Applicants assert that the language argued by the applicants is shown above in italics. This language was recited in the claim, in a similar form, when the application was originally filed over seven years ago. This language has been argued by the applicants as distinguishing the claimed invention over the cited references in numerous correspondences with the Patent Office, yet the examiner still claims that the language is not found in the claim. As shown above, the language is indeed in the claim.

Accordingly, since the elements of the claimed invention that applicants have argued are recited in the claim and are not taught or suggested by the references, applicants assert that independent claim 1 is allowable.

Claim 17, which the examiner rejected based on the same rationale as claim 1, also includes similar elements recited in the claim.

Accordingly, applicants assert that independent claim 17 is allowable over the cited references.

Independent claims 6 and 15 recite these features, among others, and are therefore also allowable.

Claims 2-5 depend from independent claim 1, claim 7-14 depend from independent claim 6, claim 16 depends from independent claim 15 and claims 18-20 depend from independent

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claim 17. Therefore, since each of the independent claims are allowable, each of the dependent claims are also allowable.

Issue No. 4: Applicants have argued that Ofek teaches only one connection between the local system 10 and the remote system 11, that there is no second connection and, specifically, no second connection through a data storage system. In response to this argument, the examiner seems to support the applicants' position by stating that Ofek teaches a communications link 12 that interconnects the local system 10 and the remote system 11. That is only one connection. There are no others.

This argument was not disputed in the Advisory Action. Therefore, applicants assert that, since Ofek does not teach the elements recited in the claims, the 35 U.S.C. §103(a) rejections are improper and should be withdrawn.

Issue No. 5: Applicants have argued that, even if the references were combined, the combination would not teach the invention recited claim 17. This argument was not disputed in the Advisory Action.

Therefore, applicants assert that, since the combination relied upon by the examiner does not teach the elements recited in the claim, the 35 U.S.C. §103(a) rejections are improper and should be withdrawn.

Issue No. 6: Applicants have argued that Yanai, Ofek and Ji do not teach or suggest the invention claimed in claim 6, alone or in combination, because there is no motivation to combine the references. This argument was not disputed in the Advisory Action.

Therefore, applicants assert that, since the combination relied upon by the examiner does not teach the elements recited in the claim, the 35 U.S.C. §103(a) rejections are improper and should be withdrawn.

In view of the foregoing, the applicants' believe that the application is in condition for allowance and respectfully request favorable reconsideration.

In the event the Examiner deems personal contact desirable in the disposition of this case, the Examiner is invited to call the undersigned attorney at (508) 293-7835.

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Please charge all fees occasioned by this submission to Deposit Account No. 05-0889.

Respectfully submitted,

Dated: _____

9/6/05



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